

REMARKS

Applicants respectfully request reconsideration of this Patent Application, particularly in view of the above Amendment and the following remarks. No additional fee is required for this Amendment as the number of independent claims has not changed, and the total number of claims has not changed.

Amendment to the Claims

Applicants have amended Claims 1, 12-23, 27, 35, 39, 40, 42, 43, 46, 47, 50, 51, 54, 55, and 58 to clarify the claimed invention, provide proper antecedent bases, and/or to correct typographical errors.

No new matter has been added to the claims by this Amendment.

Telephone Interview Summary

Applicants thank the Examiner and her Supervisor for their time and comments made during a telephone interview with Applicants' undersigned attorney on 23 June 2003. The prior art rejections were discussed as well as the Examiner's classification in the Office Action of Claims 1, 22-26, and 80 as product-by-process claims.

Regarding the rejection of Claims 1-27, 29-60, and 80-84 under 35 U.S.C. §102(b) as anticipated by Ohama, U.S. Patent 5,703,152, the undersigned argued that Ohama does not disclose a water-insoluble coating material including a masking agent and a binding agent for coating activated carbon. The undersigned argued that the Examiner's combination of various, unrelated elements taken from distinct and separate embodiments is improper without an express disclosure or suggestion in Ohama to make such a combination. More particularly, the undersigned argued Ohama discloses pigments, resins, and blowing agents in the resinous compositions disclosed starting at Column 4, line 31, such as paint, ink, and molding resins, and these materials are not disclosed in any type of combination with activated carbon anywhere in Ohama, and thus the Examiner was improperly assembling Applicants' claimed invention from parts taken from the several distinct, unrelated and non-combinable embodiments disclosed in Ohama.

The Examiner pointed to Column 2, lines 15-22, of Ohama where Ohama describes a "deodorizing resin composition" that comprises an aqueous slurry of the iron (II) compound, a chelating agent, a porous substrate, a resin, and water. The Examiner argued that at Column 4, lines 20-24, that Ohama discloses that an aqueous slurry can be mixed with activated carbon. The Examiner argued this aqueous slurry can be any aqueous slurry of Ohama, including the "deodorizing resin

composition.” The undersigned pointed out to the Examiner that the “deodorizing resin composition” disclosed at Column 2, lines 15-22, is not the particular aqueous slurry that is being applied to the activated carbon in Ohama.

The undersigned argued that a proper reading of Ohama first provides, at Column 2, lines 8-14, a “deodorizing composition,” which is not disclosed as including a resin, and that, beginning at Column 2, line 64, Ohama again describes the “deodorizing composition” which is added, with no disclosure or suggestion of including a water-insoluble resin, to the activated carbon at Column 4, lines 20-24. The undersigned argued that the “deodorizing composition” is different than the “deodorizing resin composition” in that the “deodorizing composition” does not include a resin, and that Ohama does not disclose the particular aqueous slurry of the “deodorizing resin composition” can be mixed with and dried onto activated carbon or otherwise impregnated in a fibrous material. No agreement was reached as to the rejection over Ohama.

The undersigned argued independent Claims 1 and 80 are not product-by-process claims. The Examiner agreed that Claim 80 is not a product-by-process claim. No agreement was reached as to whether pending Claims 1 and 22-26 are product-by-process claims.

The undersigned argued that Applicants' claimed invention was not anticipated by Mauro et al., U.S. Patent 5,480,636, particularly as Mauro et al. does not disclose or suggest a coating material for activated carbon. The Examiner agreed with the undersigned's arguments that Applicants' claimed invention is not anticipated by Mauro et al.

Claim Rejections - 35 U.S.C. §102

Claims 1-27, 29-60, and 80-84 have been rejected under 35 U.S.C. §102(b) as being anticipated by Ohama, U.S. Patent No. 5,703,152. The Examiner alleges that Ohama discloses a deodorizing composition including a hydrophobic resinous binding agent, a masking agent, and a blowing agent, and that this deodorizing composition can be sprayed on activated carbon. Applicants' respectfully disagree with the Examiner, and note that the deodorizing composition of Ohama that is used in combination with activated carbon does not include a water-insoluble binding material, pigment, or a blowing agent. Ohama discloses the resinous materials, pigments, and/or blowing agents are used in paint compositions, ink compositions, or resin compositions for molding articles, which are distinct and separate embodiments from the deodorizing article including activated carbon, which is also disclosed in Ohama.

Ohama discloses both a “deodorizing composition” and a “deodorizing resin composition” (*See for example:* the Title; the Abstract; Column 1, lines 6-8; and Column 1, lines 43-67). Both of these distinct compositions can include an aqueous slurry, but the “deodorizing resin composition” is disclosed at Column 2, lines 15-22, as including the elements of the “deodorizing composition” plus a resin. In other words, the “deodorizing resin composition” disclosed at Column 2, lines 15-22, includes a resin and the “deodorizing composition” disclosed at Column 2, lines 8-14, does not include a resin. The Examiner alleges this resin is equivalent to Applicants’ claimed binding agents.

Applicants understand the Examiner’s current position, particularly by her comments made during the telephone interview on 23 June 2003, to be that Ohama discloses either of these two compositions can be applied onto, and therefore coat, activated carbon. The Examiner alleges support for her continued rejection is found at Column 4, lines 18-24, where Ohama discloses:

The aqueous slurry according to the present invention may be used as an additive for the production of deodorizing articles. For example, the aqueous slurry is mixed and kneaded with an adsorbent such as activated carbon, zeolite, alumina, silica or magnesia, and the resulting mass is molded and dried, thereby to give a shaped, deodorizing article.

During the telephone interview, the Examiner alleged the “aqueous slurry” discussed in the foregoing passage from Ohama can be any of the particular aqueous slurries

disclosed in Ohama, for example, either the aqueous slurry of the “deodorizing composition” that does not include a resin, or the aqueous slurry of the “deodorizing resin composition” that does include a resin. However, the Examiner’s foregoing interpretation is not supported by the disclosure of Ohama, and Applicants respectfully disagree with the Examiner. Only the “deodorizing composition” is disclosed by Ohama in combination with activated carbon. Ohama does not disclose a combination of activated carbon with a resin material, a pigment, and/or a blowing agent.

As discussed above, Ohama discloses both a “deodorizing composition” and a “deodorizing resin composition.” Such a distinction is important when reading the disclosure of Ohama. At Column 2, lines 64-67, under the heading “Best Mode For P[r]acticing the Invention,” Ohama discloses the “deodorizing composition” includes an aqueous slurry of: 1) water; 2) an iron (II) compound; 3) a chelating agent; and 4) a porous substance. Ohama continues at Column 3, line 1 through Column 4, line 11, to disclose particulars of these elements of the aqueous slurry of the “deodorizing composition.” **Ohama does not disclose including a water-insoluble resin, a pigment material, or a blowing agent in the aqueous slurry “deodorizing composition.”**

Ohama discloses several uses of the aqueous slurry “deodorizing composition” at Column 4, lines 12-30. At Column 4, lines 18-22, the aqueous slurry “deodorizing composition” is disclosed as mixable and kneadable with activated carbon and dried to give a shaped “deodorizing article.” The disclosure of Ohama from Column 2, line 64 - Column 4, line 30 relates to the “deodorizing composition” that does not include a resin, pigment, or blowing agent. Therefore, Ohama does not teach activated carbon coated with a water-insoluble or a colored coating material including a masking agent or pigment and a water-insoluble binding agent, as in Applicants’ claimed invention.

After disclosing the aqueous slurry “deodorizing composition” can be mixed with activated carbon, Ohama discloses at Column 4, lines 31-34, that:

The aqueous slurry **may also be** used as a component for the preparation of **a resinous composition** such as a paint composition, an ink composition or a molding resin composition. (emphasis added).

Ohama begins disclosure of the best mode of the “deodorizing resin composition” with the above sentence and continues disclosing the various embodiments of the invention including the “deodorizing resin composition” through Column 6, line 58. This disclosure of the “deodorizing resin composition” begins after the disclosure of applying the non-resinous “deodorizing composition” to activated carbon. Ohama does not disclose or suggest using the “deodorizing resin compositions” such as the

deodorizing paint composition, the deodorizing ink composition, or the deodorizing molding resin composition in combination with activated carbon.

Ohama only discloses resins, pigments, and/or blowing agents in combination with the aqueous slurry “deodorizing resin composition” used in the paint composition, ink composition, and resin composition. In order to anticipate a claim, the prior art must disclose every element of the claimed invention as arranged in the claim under review. *In re Bond*, 15 USPQ2d, 1566, 1567 (Fed. Cir. 1990). Ohama does not disclose or suggest activated carbon in combination with a “deodorizing resin composition” such as the paint composition, ink composition, or molded resin composition, or any component of these distinct compositions. In other words, the Examiner has identified individual components disclosed in the several distinct embodiments (e.g., paint resins) of Ohama that are alleged to be similar to elements of Applicants’ invention (e.g., binding agents), and has combined these components of Ohama in a manner not disclosed or suggested in Ohama.

For the reasons presented above, Applicants respectfully submit that amended independent Claims 1-27, 29-60, and 80-84 are not anticipated by Ohama.

Applicants note that the Examiner on page 4 of the Office Action has apparently misunderstood the limitations of dependent Claims 24 and 25. For example, Applicants’ Claim 24 recites the masking agent is more concentrated at an

outer surface of the coating material than at an inner surface of the coating material, not, as the Examiner alleges, that the masking agent “is more concentrated than the coating material.”

The Examiner, also at page 4 of the Office Action, has alleged that Ohama discloses, at Column 9, lines 8-10, that “the coating composition was applied to a surface of a round filter that contained activated carbon having a diameter of 2mm.” Applicants note that at Column 9, lines 8-10, Ohama discloses paint composition C was applied to a surface of a “round filter paper having a diameter of 20 cm.” Filter paper does not typically contain activated carbon, and Ohama does not disclose that this specific filter paper contains activated carbon. Applicants assert that Ohama does not apply the resinous, pigmented paint composition to activated carbon.

Alleged Product-by-Process Claims

The Examiner has classified Claims 1, 22-26, and 80 as product-by-process claims. As discussed above, the Examiner agreed with the undersigned that Claim 80 is not a product-by-process claim. A product-by-process defines a claimed product by a process or method step by which the product is made. Applicants’ dependent Claims 22 and 26 are, at least in part, product-by-process claims. Claims 1 and 23-25 are not product-by-process claims, as these claims do not recite any

process limitations. Applicants have amended Claim 1 to further clarify the claimed invention. Applicants respectfully request reconsideration of the Examiner's analysis of Claims 1 and 23-25 as product-by-process claims, and request each limitation be considered for patentability.

Claim Rejections - 35 U.S.C. §102

Claims 1-27, 29-60, and 80-84 have been rejected under 35 U.S.C. §102(b) as being anticipated by Mauro et al., U.S. Patent No. 5,480,636.

Applicants understand from the Examiner's comments during the telephone interview that the rejection over Mauro et al. has been withdrawn. Mauro et al. discloses at Column 1, lines 16-39, that activated carbon and impregnated activated carbon is known as an odor removing adsorbent. Mauro et al. discloses titanium dioxide particles as an alternative adsorbent material. Mauro et al. does not disclose activated carbon coated with a water-insoluble coating material including a masking agent or pigment and a water-insoluble binding agent, as in Applicants' claimed invention.

Prior Rejections

Applicants note that the Examiner, on page 5 of the Office Action, that the rejection of Claims 40, 46, and 54 under 35 U.S.C. §103(a) as unpatentable over Ohama, U.S. Patent No. 5,703,152, in view of Pyzel, U.S. Patent No. 3,731,678, made in previous Office Actions, has been overcome by Applicants' arguments. However, the Examiner has not indicated these particular claims are allowable, and has now rejected these claims as anticipated by Ohama alone. As the Examiner previously indicated that Ohama did not disclose each element of these claims, Applicants respectfully request clarification of the status of dependent Claims 40, 46, and 54. If the Examiner maintains the rejection of Claims 40, 46, and 54 under 35 U.S.C. §102(b), which Applicants believe is inconsistent with her prior statements, Applicants respectfully request the Examiner specifically point out the claim limitations in Ohama so Applicants are clear as to the Examiner's rejection and can respond accordingly.

Likewise, the rejection of Claims 7, 44, 45, 52, and 53 under 35 U.S.C. §103(a) as being unpatentable over Ohama, U.S. Patent 5,703,152, in view of Mauro et al., U.S. Patent 5,480,636, and further in view of *Hawley's Condensed Chemical Dictionary*, 14th Edition, has not been repeated in the outstanding Office Action, yet Examiner has not indicated these particular claims are allowable, and has now

rejected these claims as anticipated by Ohama alone. As the Examiner previously indicated that Ohama did not disclose each element of these claims, Applicants respectfully request clarification of the status of Claims 7, 44, 45, 52, and 53. If the Examiner maintains the rejection of Claims 7, 44, 45, 52, and 53 under 35 U.S.C. §102(b), which Applicants believe is inconsistent with her prior statements, Applicants respectfully request the Examiner specifically point to the claim limitations in Ohama so Applicants are clear as to the Examiner's rejection and can respond accordingly.

Comments on the Examiner's "Response to Arguments"

In reading the Examiner's "Response to Arguments" on page 7 of the Office Action, Applicants believe the Examiner has misunderstood Applicants' prior arguments. Applicants want to focus on a few selected concerns.

The Examiner states:

Applicant argues that the Ohama reference teaches mixing and kneading the composition with activated carbon. Ohama teaches that the composition can be impregnated onto the fibrous article. Additionally, the manner in which the composition is put onto the activated carbon does not make the composition different. Process limitations in product claims are not given any patentable weight.

Applicants had argued that the deodorizing composition of Ohama is mixed with the activated carbon and dried thereon with no binding agent, more particularly no water-

insoluble binding agent. Applicants' point to the method by which Ohama applies the deodorizing composition only in showing Ohama does not disclose a water-insoluble binding agent. Applicants' water-insoluble binding agent is one reason Applicants' invention is patentable over Ohama.

Applicants also note that the forgoing quotation refers to "the composition" and in the sentence prior (not provided herein) to the foregoing quote, the Examiner refers to the "paint composition." To be clear, Applicants do not argue the paint composition is mixed and kneaded with the activated carbon. Applicants argue the paint composition of Ohama is not mixed with the activated carbon.

The Examiner states at page 7 and continuing on page 8, that:

Applicant further argues that Ohama reference does not disclose the activated carbon in combination with the paint, ink or resin component. The examiner does not agree because in column 4, the reference specifically states that the activated carbon aqueous slurry can be formed into a shape, which can be combined with a resinous or paint composition. Therefore, the activated carbon is in contact with the other materials.

Applicants cannot find in Column 4 of Ohama where Ohama "specifically states" that the "deodorizing article" formed of the aqueous slurry mixed with the activated carbon can be combined with a resinous or paint composition. Ohama does not disclose or suggest that the activated carbon is coated with the resinous or paint composition; this has been the thrust of Applicants' arguments to date. Applicants

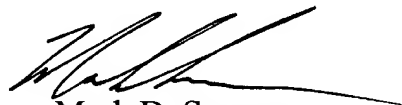
respectfully request the Examiner provide more detailed citations for such definitive statements so Applicants can more clearly and accurately respond accordingly and thereby expedite prosecution of this patent application.

Conclusion

Applicants intend to be fully responsive to the outstanding Office Action. If the Examiner detects any issue which the Examiner believes Applicants have not overcome in this response, Applicants' undersigned attorney requests a telephone interview with the Examiner.

Applicants sincerely believe that this Patent Application is now in condition for allowance and, thus, respectfully request early allowance.

Respectfully submitted,



Mark D. Swanson
Regis. No. 48,498

Pauley Petersen Kinne & Erickson
2800 West Higgins Road
Suite 365
Hoffman Estates, Illinois 60195
(847) 490-1400
FAX (847) 490-1403